

REMARKS

This is in response to the Office Action mailed on July 23, 2004, in which all of the pending claims (15-30) were rejected.

Independent claim 15

Independent claim 15 recites a tape roll that includes a central tape roll axis and a length of tape circumferentially wound about the axis, the tape having first and second sides. The second side (which faces inward, toward the axis) is at least partially covered with pressure sensitive adhesive. The tape roll also includes a tab having first and second sides. At least a portion of the second side of the tab is covered with pressure sensitive adhesive. The adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll, so that the trailing end of the tape overlays the tab between first and second ends of the tab.

The Examiner rejected independent claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Dills (USP 4,512,462) in view of Hammond (USP 2,015,268). The Examiner contended that Dills discloses all of the elements of the claim except that the tab has an adhesive section. The Examiner turned to the teachings of Hammond to supply this deficiency, contending that it would have been obvious to utilize the adhesive tab strip disclosed by Hammond in the invention of Dills, with the motivation being "to provide for releasability of the tab from the tape surface."

Dills discloses a tape roll (22) having a removable, reusable tab (10) with an opening (18). A portion of the tape (20) projects through the opening (18) of the tape roll (22) and is readhered to the roll. See FIGS. 2 and 3 and the description at column 2, lines 49-66. The tab (10) does not have adhesive on either of its sides, but instead relies on the adhesive of the tape (20) that projects through the opening (18) to adhere the tape (20) and tab (18) together to the tape roll (22).

Hammond discloses a tape roll having a tab strip (c) having adhesive on one side so that it is adhered to the tape roll coil (e). The tab strip (c) also has a plurality of holes punched in it, to reduce the level of adhesion between the tape (b) and the tab strip (c). See FIG. 1 and the description on the right-hand column of page 1, lines 20-53. The tape (b) overlays all of the tab strip

(c), so that no portion of the tab strip (c) is exposed. This configuration is shown in FIG. 1 of the instant application, described as "overtabbing" which is known in the art (and the problems of which are described in the background portion of the instant application).

The Examiner has proposed a combination of Dills and Hammond, contending that this combination renders obvious the subject matter recited by independent claim 15. In order to reject a claim as being obvious over a combination of references, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See M.P.E.P. 2143.

In this case, there is no teaching or suggestion to combine the references cited by the Examiner in the manner recited by claim 15; the only motivation to combine these references is provided by the Applicant's disclosure. The Examiner proposes modifying the tab (10) of Dills to include an adhesive portion for securing the tab to the tape roll (22), along the lines taught by Hammond. However, this modification would render useless the opening (18) in the tab (10) that is taught by Dills to be provided explicitly for the purpose of sticking the tab (10) to the roll (22). See column 3, lines 7-10. Because Dills already teaches a structure designed to provide adherence to the tape roll (via the tape projecting through an opening), one skilled in the art would have no motivation to modify the teachings of Dill to provide adhesive on the tab itself for adherence to the tape roll. Because the requisite suggestion or motivation to combine the teachings of Dills and Hammond is lacking, the combination of these references is not proper, and the rejection of claim 15 under 35 U.S.C. § 103(a) should accordingly be withdrawn.

Dependent claims 16 and 20

The Examiner also rejected dependent claims 16 and under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. The Examiner pointed to the perforations (d)

of Hammond as providing the claimed non-adhesive portion of the tab. With this Amendment, claim 16 is amended to recite that the second side of the tab comprises a non-adhesive portion adjacent to the first end of the tab and an adhesive portion adjacent to the second end of the tab. Amended claim 16 is not disclosed by the combination of Dills and Hammond, as Dills teaches no adhesive on the tab and Hammond teaches perforations spaced throughout the area of the tab in order to reduce the overall level of adhesion between the tab and the tape. Neither reference teaches or suggests a non-adhesive portion adjacent to one end of the tab and an adhesive portion adjacent to the other end of the tab. Because the combination of Dills and Hammond fails to disclose all of the elements of amended claim 16 (and also because claim 16 depends from allowable independent claim 15), the rejection of claim 16 under 35 U.S.C. § 103(a) should be withdrawn.

Claim 20 depends from amended claim 16, and is allowable therewith.

Dependent claims 17-19

Dependent claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond and McLaughlin (USP 6,663,932). Claim 17 depends from amended claim 16. McLaughlin does not disclose a tab having non-adhesive and adhesive portions as recited in amended claim 16. Therefore, for the reasons discussed above with respect to claim 16, the rejection of claim 17 should be withdrawn.

Dependent claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond and Rosen (USP 3,247,956). Claims 18 and 19 each depend from amended claim 16. Rosen does not disclose a tab having non-adhesive and adhesive portions as recited in amended claim 16. Therefore, for at least the reasons discussed above with respect to claim 16, the rejection of claims 18 and 19 should be withdrawn.

Dependent claims 21-23 and 26-30

Claims 21-23 and 26-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond. Claims 21-23 and 26-30 depend from independent claim 15, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features recited in claims 21-23 and 26-30 are patentable on their own merits, although this does not need to

be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Dependent claims 24 and 25

Claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dills in view of Hammond and Rosen. Claims 24 and 25 depend from independent claim 15, and are allowable therewith. In addition, the Examiner's argument that "it would have been obvious for the adhesive of Dills to exhibit [the characteristics of having adhesive strength less than that of the tape or repositionable pressure sensitive adhesive] because the adhesive present in the hole of the tab is limitedly exposed for less strength and repositionability" is improper. The Examiner's argument is directed to the characteristics of Dills without modification by the teachings of Hammond, which according to the Examiner's proposed combination (with which, as stated above, the Applicant does not agree) provides an adhesive to the tab for adherence to the tape roll. Arguments about the characteristics of Dills' teachings, absent this modification, are not relevant. However, claims 24 and 25 are allowable in any case, since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

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Application No.: 10/664,429

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CONCLUSION

In view of the foregoing, all pending claims 15-30 are in condition for allowance.
A Notice to that effect is respectfully requested.

Respectfully submitted,

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Date: 10/21/04

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